

### **REMARKS**

Applicant respectfully request reconsideration. This amendment is being filed in response to the notice of non-compliant amendment mailed October 28, 2009. Applicant has corrected claims 10 and 49 to reflect correctly the deleted text.

Claims 1, 3-5, 8-16, 44, and 49-54 were previously pending in this application. Claims 3-5, 8-16, and 49-54 have been amended. Claims 3-5, 8-16, and 49-54 have been amended to more clearly recite the relationship between these claims and the independent claims from which they depend. In addition, claims 13, 14, 16, 49, and 50 have been amended to clarify the properties of the backbone. As a result, claims 1, 3-5, 8-16, 44, and 49-54 remain pending for examination with claims 1 and 44 being independent claims. No new matter has been added.

#### **Claim Rejections under 35 U.S.C. §112**

Claims 3-5, 8-16, and 49-54 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action states that claims 3-5, 8-16, and 50-54 are indefinite in reciting “an article” because one of ordinary skill in the art would not be able to determine whether these claims require all that is required of the article of the base claim or whether these claims are drawn to only one potential embodiments of the base claim. While Applicant does not agree that the claims are unclear as written, claims 3-5, 8-16, and 50-54 have been amended to recite “the article” of the independent claim from which they depend.

The Office Action also states that claim 49 is indefinite in reciting “a kit as in claim 44” because one of ordinary skill in the art would not be able to determine whether claim 49 requires all that is required of the kit of claim 44 or whether claim 49 is drawn to only one potential embodiment of base claim 44. While Applicant does not agree that claim 49 is unclear as written, claim 49 has been amended to recite “The kit of claim 44.”

In addition, the Office Action states that claims 13, 14, and 16 are indefinite in reciting “the polymeric backbone.” The Office Action states that one of ordinary skill in the art could interpret claim 1 to encompass polymers that have a backbone which itself was not polymeric or a polyester,

but that comprise “side-chain” polyesters. While Applicant does not agree that the claims are unclear as written, claims 13, 14, and 16 have been amended to recite “the backbone” rather than “the polymeric backbone.”

The Office Action also states that claim 49 is indefinite in reciting “the polymer.” The Office Action asserts that it is unclear whether the antecedent basis for “the polymer” is the “polymeric nanoparticle” or “the polymer having a backbone.” Claim 49 has been amended to recite “the backbone comprises a graft co-polymer.”

Accordingly, Applicant respectfully requests withdrawal of the claim rejections on these grounds.

#### Claim Rejections Under 35 U.S.C. §102

Claims 1, 3-5, 8-16, 44, and 49-53 stand rejected and newly added claim 54 was rejected under 35 U.S.C. §102(a) and 102(e) as being anticipated by U.S. Patent Publication 2003/0134420 to Lollo et al. (hereinafter, “Lollo”).

Regarding claims 1 and 44, the Office Action states, referring to paragraph [0068] of the instant specification, that “a polymer having a backbone comprising a polyester” would include articles in which the polyester component is a side-chain or branch or otherwise associated component to any backbone molecule. Applicants respectfully disagree.

Applicants believe that one of ordinary skill in the art would understand that “a polymer having a backbone comprising a polyester” clearly means that polyester is part of the backbone. Further, Applicants believe that one of ordinary skill in the art would recognize that the term “backbone” would not include side-chains or branches. Rather, the term “backbone” refers to the portion of the polymer to which side-chains and/or branches are attached.

Lollo does not disclose the use of a polymer having a backbone comprising a polyester. Therefore, Lollo fails to teach or make obvious each and every limitation of claims 1 and 44. Because each claim limitation is not taught or made obvious, claim 1 and 44 are patentable over Lollo. Claims 3-5, 8-16, and 49-53 depend from claims 1 and 44, and are therefore patentable for at least the above reasons. Accordingly, Applicant respectfully requests withdrawal of the claim rejections on this ground.

Claims Rejections Under 35 U.S.C. §103

Claims 1, 3-5, 8-16, 44 and 49-54 were rejected under 35 U.S.C. §103(a) over Lollo in view of Pistel et al. in “Brush-like branched biodegradable polyesters, part III: Protein release from microspheres of poly(vinyl alcohol)-graft-poly(D,L-lactic-co-glycolic acid)” (hereinafter, “Pistel”).

The Office Action asserts that Pistel teaches articles for delivering a drug comprising a nanoparticle comprising a polymer having a backbone comprising a polyester. Further, the Office Action states that it would have been obvious to one of ordinary skill in the art to have used the backbone of Pistel in the article of Lollo. Applicants respectfully disagree.

Applicants note that, even if one were to combine the articles of Pistel and Lollo, one would not produce the articles taught in claims 1 and 44. Specifically, Pistel does not teach the use of backbones comprising a polyester. Rather, Pistel teaches the grafting of poly(lactic-co-glycolic acid), PLGA, onto water-soluble poly(vinyl alcohol) (PVAL) backbones. Polyvinyl alcohol does not comprise ester groups. Therefore, the polyvinyl alcohol backbones do not comprise a polyester.

Therefore, Pistel fails to cure the deficiencies of Lollo noted above with respect to claims 1 and 44. Thus, claims 1 and 44 are patentable over the Lollo and Pistel combination for at least the reasons mentioned above. Claims 3-5, 8-16, and 49-54, which depend from claims 1 and 44, are also patentable for at least these reasons. Accordingly, Applicant respectfully requests withdrawal of the claim rejections on this ground.

**CONCLUSION**

In view of the foregoing, it is believed that the pending application is in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this response, that the application is not in condition for allowance, the Examiner is requested to call the undersigned at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, any necessary extension of time is hereby requested. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 23/2825 under Docket No. S1507.70000US00 from which the undersigned is authorized to draw.

Dated: 11 / 18 / 2009

Respectfully submitted,

By 

Timothy J. Oyer, Ph.D.

Registration No.: 36,628

WOLF, GREENFIELD & SACKS, P.C.

Federal Reserve Plaza

600 Atlantic Avenue

Boston, Massachusetts 02210-2206

617.646.8000